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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,307	04/10/2006	Jochen Ackerman	273100US0PCT	8081
22850 7590 04/11/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHO, JENNIFER Y	
			ART UNIT	PAPER NUMBER
			1621	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/541,307	ACKERMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Y. Cho	1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 1-3, 7-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/5/2005</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **Detailed Action**

### **Claim Objections**

Claims 1-3, 7-15 are objected to because of the following informalities: The claims refer to numbered stages, evaporators and apparatus, which are not explained within the claim language. The claims should be self-explanatory from a reading of the claims. Appropriate correction is required. The Examiner suggests that either the numbers should be deleted or the claim language should include more description of the stages, evaporators and apparatus and how they are connected.

### **Claim Rejections – 35 USC 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 10-12 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Geisendoerfer et al. (US Patent Publication 2004/0171868 A1).

Geisendoerfer et al. teaches a process for the preparation of higher (meth)acrylic esters by transesterifying a lower (meth)acrylate, including methyl (meth)acrylate, with an alcohol, in the presence of a catalyst or catalyst mixture (page 4, section 81, 86, 89, 90 and 91). The alcohol includes n-butanol (page 5, section 95, line 1) and the catalyst is a homogeneous titanate alcoholate (page 5, section 109, lines 3-4). In a vacuum evaporation stage, as shown by the reduced pressure of 100-200 mbar (page 9, section 191), the bottom effluent product is divided (page 8, section 189), and recycled back to the reaction apparatus for further transesterification (page 8, section 190). Furthermore, the bottom effluent from a thin-film evaporator (page 8, section 167) is divided and partly fed back to the reaction apparatus for transesterification (page 8, section 170). The bottom effluent mixture to be recycled partly from the thin-film evaporator to the transesterification reaction apparatus, is in the amount of 60-95% (page 8, section 170, line 2). Therefore these claims are fully met.

### **Claim Rejections – 35 USC 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geisendoerfer et al. (US Patent Publication 2004/0171868 A1).

The teaching of Geisendoerfer et al. has been discussed earlier.

In reference to claims 7-9, 13-15, Geisendoerfer et al. does not discuss the exact percentage of the bottom effluent that is recycled from the vacuum evaporator to the transesterification reaction apparatus, nor the sum of the percentages of the bottom effluents to be recycled from both the vacuum evaporator and the film evaporator. Though Geisendoerfer et al. does state that the bottom products can be combined and treated (page 9, section 193) and then fed to the transesterification reaction apparatus (page 9, section 194).

However, it is the position of the examiner that one of ordinary skill in the art, at the time of the invention, would through routine and normal experimentation determine the optimization of the percentages of the bottom effluents to be recycled from the vacuum evaporator and the film evaporator, to provide the best effective variable depending on the results desired. The applicant does not show any unusual and/or unexpected results for the percentages stated.

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time of the invention, to optimize the bottom effluent percentages. The expected result would be an improved process for the preparation of (meth)acrylates, while recycling the homogeneous titanium catalyst.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272 6246. The examiner can normally be reached on 9 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272 0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Cho  
Patent Examiner  
Art Unit: 1621

THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Thurman Page  
Supervisory Patent Examiner  
Technology Center 1600